

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 7, 10, 11, 15, 18, 19 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In independent claims 1, 10, 18 and 23 appear to contain new matter in the amendment filed on June 24, 2009. Specifically the amendment claims, "the relief area is bounded on at least three sides by the outer periphery of the contact area", which is claimed in some form in all the independent claims. The support for this is not clearly stated in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 7, 10, 11 and 15 rejected under 35 U.S.C. 102(b) as being anticipated by Bolanos et al. (U.S. Patent No. 5,471,756).

Bolanos et al. disclose an instrument (110) having an elongated central portion (that is generally cylindrical-126) defining opposed first and second ends (adjacent to the sizing number 129), a first contact portion (133) having a contact area including an outer periphery having a circumference and extending from the first end of said elongated central portion, a second contact portion (143) having a contact area extending from the second end of said elongated central portion and a relief area defined on the first and second contact portions. The relief area is recessed from the outer periphery of the contact area, such that the relief area interrupts the outer periphery of the contact area. (See Figure 1 below)The relief areas for providing clearance between the instrument and the medullary canal are considered to be the surfaces 134 and 144. The relief area is bounded on at least 3 sides by the outer periphery of the contact area (see Figure 1 below). At least one of said first contact portions and said second contact portion comprises a plurality of contact areas. The multiple areas on the contact portions (133 and 144) are considered to be more than one depending on the area defined. With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Bolanos et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that

the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

It can be considered that the relief area does not extend around the entire circumference of the outer periphery. This is because one side of the recessed area could be considered a relief area and another portion of that recess can be considered a handling area. Therefore, one could interpret Bolanos et al. as having a relief area that does not extend around the entire circumference of the outer periphery. Half of the area can be considered the relief area and the other half can be considered a handling area.

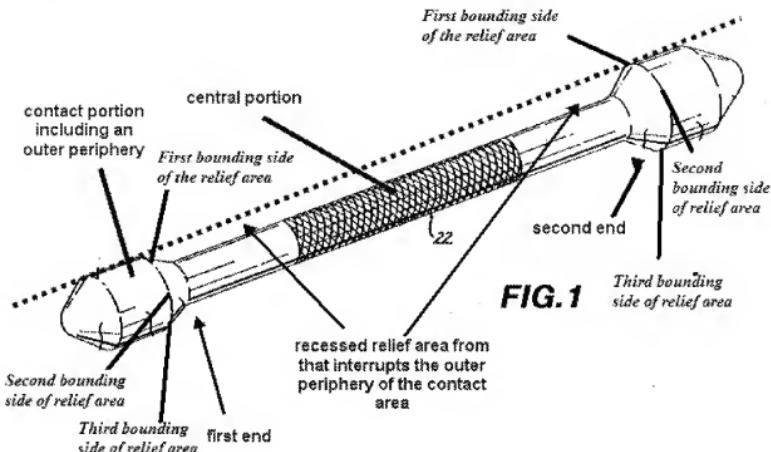


FIG. 1

Third bounding side of relief area

recessed relief area from that interrupts the outer periphery of the contact area

Third bounding side of relief area *first end*

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18, 19, 23 and 24 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Mikhail (U.S. Patent No. 5,314,493) in view of Bolanos et al. (U.S. Patent No. 5,47,756).

Mikhail discloses a method for performing joint arthroplasty comprising resecting a long bone, preparing the medullary canal of a long bone, inserting instruments into the canal, providing a plurality of centralizers for implanting into the medullary canal, determining the appropriateness of the instruments and providing a stem and implanting it into the canal of a long bone. Mikhail discloses the claimed invention except for the use of the measuring instrument as claimed in claim 1. As stated above, Bolanos et al. disclose a measuring instrument for providing a fast and simple technique for measurement of a canal (abstract). It would have been obvious to one skilled in the art at the time the invention was used the method of Mikhail with the measurement device of Bolanos et al., in order to create a faster and less complicated method for joint arthroplasty.

Response to Arguments

Applicant's arguments filed June 24, 2009 have been fully considered but they are not persuasive. Applicant argues that Bolanos does not have a relief area bounded on at least three sides by the outer periphery. It can be seen in Figure 1 above how Bolanos can be considered to be bounded on at least three sides by the outer periphery. One might argue that since this is cylindrical that it only has one side. To the contrary, the instrument can have a front, back, lateral and medial side. The relief area is bounded by all of these sides of the outer periphery of the contact area.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. ARAJ whose telephone number is (571)272-5963. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael J Araj/
Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art Unit 3775